

#### **REMARKS**

Claims 14 and 67-84 are pending and are the subject of the outstanding office action.

Applicants wish to thank Examiners Kaufman, Eyler and Elliot for the telephonic interview on February 26, 2003 to discuss the objections and rejections raised in the office action.

Each of the objections and rejections set forth in the office action is addressed below.

Pursuant to the Examiner's request, the title of the invention has been amended, as shown herein.

The reference to Applicants' respective prior applications ("Related Applications") has also been amended on page 1 of the specification, pursuant to the Examiner's request.

Formal drawings are being filed concurrently with this Response to correct the informalities noted by the draftsman. The Brief Description of the Drawings on page 7 of the specification has been amended to bring the figure numbering into conformance with the numbering used in the formal drawings.

The above-mentioned amendments to the specification and claims are illustrated on the attached pages entitled "Marked Up Version to Show Changes Made". For the Examiner's convenience, a clean copy of the now amended text in the specification and the now pending claims 14 and 67-84 is provided above.

#### **Double Patenting Rejections**

Claims 14 and 67-84 were provisionally rejected under the doctrine of double patenting over certain claims in Applicants' co-pending application serial no. 09/896,096. Upon indication of an allowance being issued in Applicants' co-pending application, the undersigned will contact the Examiner and discuss the filing of a Terminal Disclaimer in the present application.

#### **Section 112 Rejections**

Claims 14 and 67-70 were rejected under Section 112, first paragraph, as being non-enabled. To expedite the prosecution of the

claims, and without acquiescence to the merit of the instant rejection or the statements made in the office action in connection with the instant rejection, the subject claims have been amended. Applicants expressly reserve the right to pursue embodiments of the subject matter of claims 14 and 67-70 as originally presented in further continuing applications.

Claim 14, and claims depending therefrom, were rejected under Section 112, second paragraph, as being indefinite. Applicants respectfully disagree that the use of the term DcR3 has been used in any inconsistent manner. However, in view of the amendment to claim 14, as discussed above, it is believed that this rejection is now moot.

Claims 71, 76, and 80, and claims depending therefrom, were also rejected under Section 112, second paragraph, as being indefinite. Applicants respectfully disagree that the term "specifically" introduces ambiguity into the terms. Applicants have amended independent claims 71, 76, and 80 to delete the term "specifically". This amendment, which is fully supported by the application, is being made to expedite the prosecution of this application and to place the claims in condition for immediate allowance; the amendment is not being made, and should not be interpreted, as acquiescence to the rejection. Applicants do not believe that the amendment narrows the scope of the claims in any manner.

#### Priority

In the office action, the Examiner asserts that the present application is not granted benefit of priority to its provisional application no. 60/059,288. The Examiner also asserts that for prior art purposes, the effective filing date of the present application is that of its provisional application no. 60/094,640. For the reasons below, the undersigned requests that these statements regarding priority be withdrawn.

Applicants respectfully submit that the issue of priority should be held in abeyance until such a time that the patent office has a consistent and appropriate standard for assessing utility and

enablement in a patent application and in art references which the office intends to apply for prior art purposes. Applicants point out that the reference being applied by the Examiner in the Section 102(e) rejection (Emery et al., discussed below) discloses only certain sequence structure of the molecule called TR4. The inconsistency of patent office standards is clearly illustrated here - how can the disclosure of Emery et al. be deemed to satisfy requirements of utility and enablement and yet Applicants' provisional application 60/059,288 be found to lack specific utility? If the Examiner believes that Applicants' provisional application 60/059,288 fails to disclose specific utility, it is respectfully submitted that the disclosure of Emery et al. must be found to be similarly deficient.

#### Section 102 Rejections

Claims 14 and 67-83 were rejected under Section 102(e) as being anticipated by Emery et al. Applicants respectfully traverse this rejection.

The Emery et al. reference discloses certain sequence structure information for the TR4 molecule but fails to disclose any function or utility of the TR4 molecule. Emery et al. merely speculate what the function or activity TR4 might be, and the disclosure in Emery et al. relating to what TR4 may be used for or how it may be used is entirely prophetic and speculative. Contrary to the assertion in the office action (page 4), Emery et al. does not teach one skilled in the art what ligand(s) bind to TR4.

Emery et al. do not teach or suggest to one skilled in the art any DcR3 antibodies, such as claimed in the instant application, and withdrawal of the rejection is respectfully requested.

#### Section 103 Rejections

Claim 84 was rejected under Section 103(a) as being unpatentable over Emery et al. and US Patent 4,946,778. Applicants respectfully traverse this rejection.

As indicated above, the Emery et al. fails to provide a disclosure compliant with the enablement requirements of Section 112

or the utility requirements of Section 101, and therefore should not be accorded prior art status for purposes of Sections 102 or 103. Any disclosure in US Patent 4,946,778 relating to agents which can be employed as detectable labels is therefore insufficient to fill the gaps left by Emery et al. Withdrawal of this rejection is therefore respectfully requested.

Respectfully submitted,

Date: March 21, 2003

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Marked Up Version to Show Changes Made

In the Title of the Invention:

Please amend the Title as follows:

--- Antibodies to DcR3 Polypeptide, a TNFR Homolog ---

In the specification:

In the paragraph on page 1, lines 8-12, the text has been amended as follows:

---- RELATED APPLICATIONS

This application is a continuation application of Serial No. 09/157,289 filed September 18, 1998, now abandoned, which is a non-provisional application claiming priority under Section 119(e) to provisional application number 60/059,288 filed September 18, 1997 and to provisional application number 60/094,640 filed July 30, 1998, the contents of which are hereby incorporated by reference. ---

In the paragraph on page 7, lines 24-26, the text has been amended as follows:

--Figures 10A-D show[s] the results of assays to determine amplification of the DcR3 gene in various lung and colon tumors and in various colon tumor cell lines.---

In the claims:

Please amend claim 14 to read as follows:

14. (Twice Amended) An isolated antibody which binds to a DcR3 polypeptide, wherein said DcR3 polypeptide (a) [has at least about 80% amino acid sequence identity with native sequence DcR3 polypeptide comprising] comprises amino acids 1 to 300 of Fig. 1 (SEQ ID NO:1) or (b) comprises amino acids 1 to X, wherein X is any one of amino acids 215 to 300 of Fig. 1 (SEQ ID NO:1).

Please amend claim 71 to read as follows:

71. (Amended) The antibody of claim 14 wherein said antibody [specifically] binds to a DcR3 polypeptide consisting of amino acids 1 to 300 of Fig. 1 (SEQ ID NO:1).

Please amend claim 76 to read as follows:

76. (Amended) The antibody of claim 14 wherein said antibody [specifically] binds to a DcR3 polypeptide consisting of amino acids 1 to 215 of Fig. 1 (SEQ ID NO:1).

Please amend claim 80 to read as follows:

80. (Amended) An isolated monoclonal antibody which [specifically] binds to a DcR3 polypeptide consisting of amino acids 1 to 300 of Fig. 1 (SEQ ID NO:1) or consisting of amino acids 1 to 215 of Fig. 1 (SEQ ID NO:1).